



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/678,363 Confirmation No. 7086
Applicant : SURESH C. GUPTA ET AL.
Filed : October 3, 2003
Title : METHOD AND APPARATUS FOR
TURBINE/ALTERNATOR ON COMMON SHAFT DURING
START-UP
Group Art Unit : 2834
Examiner : Nicholas Ponomarenko

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION RELATING TO FILING DATE UNDER 37 C.F.R. § 181

Sir:

The filing receipt issued in the above-captioned application on December 31, 2003 indicated priority to application No. 10/446,386, filed May 28, 2003 and application No. 09/840,572, filed April 23, 2001 (now U.S. Patent No. 6,605,928). However, the filing receipt did not indicate priority to §371 application No. 09/319,390, filed June 1, 1999 (now abandoned), §363 application No. PCT/US97/22405, filed December 3, 1997, or provisional patent application No. 60/032,149, filed December 3, 1996. These applications are also in a chain of priority.

A request for corrected filing receipt was denied on January 26, 2004 stating: "A claim for priority cannot be based on an application filed after the application making the claims. 09/319,390 filing date 06/01/1999".

I hereby certify that this corresponding is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 28, 2004.

06/02/2004 CCHAU1 00000113 10678363

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Lori A. Fratangelo

(Type or Print Name of Person Making Deposit)

Lori A. Fratangelo
Signature

5/28/2004
Date

It is respectfully requested that the Commissioner exercise his supervisory authority to cause the issue of a corrected filing receipt in the above-captioned application.

35 U.S.C. § 120 Benefit of earlier filing date in the United States provides:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section. [Emphasis added.]

37 C.F.R. § 1.78 Claiming benefit of earlier filing date and cross-references to other applications provides:

(a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

- (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or
- (ii) Complete as set forth in § 1.51(b); or

(iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

(iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).

(2)(i) Except for a continued prosecution application filed under §1.53(d), any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000; or

(C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title. [Emphasis added.]

Application No. 09/840,572 was filed “before patenting or abandonment” of parent application No. 09/319,390 and made “specific reference” to application No. 09/319,390.

Application No. 09/319,390 is clearly “an application previously filed in the United States of America.”

Application No. 09/319,390 was pending from the time of its filing because within 30 months of the earliest priority date a copy of the international application (PCT/US97/22405) and the basic national fee were filed (See 37 C.F.R. §§ 1.495(b) and (c)) until it was abandoned.

In application No. 09/319,390, Applicants were granted until 30 days after the Notice to File Missing Parts, mailed July 2, 1999, to file the declarations of the inventors. On January 3, 2000, three inventors’ declarations were filed along with a Petition to File Under 37 C.F.R. § 1.47(a) on behalf of inventor Gupta who refused to sign along with the request for a five-month extension of time and payment of the required fee. The first Petition was denied because although Applicants were in the process of removing a fifth improperly named inventor (Bhargava) from the PCT application, he was not addressed in the Petition.

A Renewed Petition to File under 37 C.F.R. § 1.47(a) was dismissed without prejudice on February 23, 2001 providing two months to file a Second Renewed Petition. The decision on the Renewed Petition provided: “Specifically, applicants have at their disposal the option of filing a continuing application claiming benefit of the present international application under 35 U.S.C. 120, which includes a declaration naming the proper inventive entity (see Manual of Patent Examining Procedure 201.03).” This suggestion was made to deal with the improperly named inventor.

On April 23, 2001, before the period to file a Second Renewed Petition expired, the Applicants filed the continuation application as was suggested. Continuation

application No. 09/840,572 was filed April 23, 2001 and has now issued as U.S. Patent No. 6,605,928.

Thus, § 371 application 09/319,390 satisfied the requirements of 35 U.S.C. § 120 and 37 C.F.R. § 1.78; namely, copendency, specific reference, and having an inventor named in the prior filed application.

In view of the forgoing explanation, it is respectfully requested that the above-captioned application be granted priority to application No. 09/319,390 filed June 1, 1999; application No. PCT/US97/22405; and provisional application No. 60/032,149 and that a corrected filing receipt be issued.

The petition fee required by 37 C.F.R. §§ 1.182 and 1.17(h) in the amount of \$130.00 is filed herewith.

The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required, to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650. This Petition is being submitted in triplicate.

Respectfully submitted,

WEBB ZIESENHEIM LOGSDON
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By



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